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| APPLICATION NO.  | FILING DATE        | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.            | CONFIRMATION NO.       |
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| 10/783,358   | 02/20/2004         | Richard Carey        | STNL 2656002                   | 2399                   |
| 21909<br>CARR LLP<br>670 FOUNDERS SQUARE<br>900 JACKSON STREET<br>DALLAS, TX 75202 | 7590<br>11/12/2009 |                      | EXAMINER<br>SKINNER, SHEWANA D |                        |
|  |                    |                      | ART UNIT<br>3689               | PAPER NUMBER           |
|  |                    |                      | MAIL DATE<br>11/12/2009        | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/783,358

**Applicant(s)**

CAREY, RICHARD

**Examiner**

SHEWANA SKINNER

**Art Unit**

3689

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-7,9-11,13-15 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9-11,13-15 and 17-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

This communication is a Final Action in response to correspondence received in 6/29/2009. Claims 1-2, 5-6, 9-10 and 13-14 have been amended. Claims 4, 8, 12 and 16 have been cancelled. Claims 17-24 are new. Therefore, **Claims 1-3, 5-7, 9-11, 13-15 and 17-24** have been considered below.

### *Response to Amendment*

1. The 35 U.S.C. §103 rejections of Claims 1-6 have not been withdrawn. Applicant has attempted to overcome the prior art by adding material which was neither disclosed nor could have been anticipated the original specification. It is new matter and therefore must be cancelled. In addition, there were no additional arguments presented by applicant to overcome the prior art, consequently the 103 rejections stand.
2. The amendment filed 6/29/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In Claims 1,5,9, and 13 the language of *“selecting an architectural picture from a plurality of architectural pictures, the architectural picture showing at least a plurality of units, each unit identifying an architectural feature; selecting a unit of the plurality of units, the unit comprising: a plurality of parts; at least one parametric equation having at least one control dimension as an input, the parametric equation defining at least one physical dimension of the plurality of parts and at least one arrangement of the plurality of parts, wherein: the at least one physical dimension comprises at least one measurement of the architectural feature; the at least one physical dimension determines a relative size of at least two parts of the plurality of parts; the at least one arrangement determines a relative position of at least two parts of the plurality of parts; and the at least one physical dimension and the at least one arrangement determine at least a two-dimensional view of the unit in a first spatial dimension and a second spatial dimension; varying the at least one control dimension; in response to the varying the at least one control dimension, parametrically calculating, using the at least one parametric equation, at least the physical dimension and the arrangement, thereby defining a custom unit identifying a custom*

*architectural feature; selecting at least one profile of a plurality of profiles for at least one part of the custom unit, the at least one profile determining at least a two-dimensional view of the at least one part in a third spatial dimension and one of the first and second spatial dimensions, the third spatial dimension distinct from the first and second spatial dimensions; generating a drawing of the custom unit;”* Examiner notes applicant’s attempt to incorporate essential matter from applications stated to be related to said current application. In addition, it is noted that in the disclosure of current application, applicant states that the contents of the subsequent applications are incorporated by reference into this application. However, this statement alone is insufficient to be used to allow applicant to incorporate and amend the claims of this application with disclosures and limitation neither mentioned nor could have been anticipated by the disclosure of this application as recited. Although stated as related, the amended language recites limitation that would be classified in a technology group other than business methods, which is evidenced by the fact that the application containing said language was examined in art unit 2128 and the applications attempting to be related have completely different embodiments from the current application.. In addition, said language has been added as amendments to the independent claims to, as applicant explains, recite the distinguishing characteristics of the present invention. That withstanding, said language is reasoned to be essential to the invention and should have been included in the disclosure of the current invention, at least as an embodiment or explicitly detailed as to the location of its contents in the related applications being used to introduce said language to the current application. Lastly, provisional used as a reference of priority and used to tie the different applications together is simply 88pgs of views of architecture and dimensional definitions. There is not even one claim recited. In conclusion, the line of incorporation recited on page 1 of the specification of the current application is insufficient and the amended claim language is being reasoned as new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

1. The 35 U.S.C. §112 2<sup>nd</sup> rejections of Claim 1 has not been withdrawn. Although applicant has added a step that would remedy the omitted step rejection, said step is not within the original disclosure and is therefore new matter that must be cancelled. Subsequently the rejection stands.

2. The amendment filed 6/29/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In claims 1, 5,9, and 13 the step of *"if a suitable unused part exists in the inventory of unused parts, then selecting the suitable unused part for the assembly the custom architectural feature identified by the custom unit;"*. Applicant states support for amended language on pg 18 lines 19-21, however those lines discuss the mold and not the unused parts. Page 17 lines 16-21 discuss the unused part being in the inventory, however it does not state that said part is then selected for assembly.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. The amendment filed 6/29/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In claim 18 *"graphically displaying the two-dimensional view of the unit in the first spatial dimension and the second spatial dimension; graphically displaying a relationship between the control dimension and the at least one physical dimension of the plurality of parts; and graphically displaying a relationship between the control dimension and the at least one arrangement of the plurality of parts"*. Language is reasoned to be new matter for the same reasons noted in bullet point 2 above.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. The amendment filed 6/29/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In claim 19 *"graphically displaying the two-dimensional view of the unit in the first spatial dimension and the second spatial dimension; graphically displaying a relationship between the control dimension and the at least one physical dimension of the plurality of parts; and graphically displaying a relationship between the control dimension and the at least one arrangement of the plurality of parts."* Language is reasoned to be new matter for the same reasons noted in bullet point 2 above.

Applicant is required to cancel the new matter in the reply to this Office Action.

6. The amendment filed 6/29/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: In claim 20 *“modifying the at least one part of the custom unit by adding an additional feature to the at least one part”*. Language is reasoned to be new matter for the same reasons noted in bullet point 2 above.

Applicant is required to cancel the new matter in the reply to this Office Action.

7. The amendment filed 6/29/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: In claim 21 *“selecting an offset for the at least one part of the custom unit, the offset comprising an amount of translation of the at least one part in the third spatial dimension from a default backing position.”*. Language is reasoned to be new matter for the same reasons noted in bullet point 2 above.

Applicant is required to cancel the new matter in the reply to this Office Action.

8. The amendment filed 6/29/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: In claim 22 *“wherein the selecting an offset further comprises graphically displaying the two-dimensional view of the at least one part in the third spatial dimensional and the one of the first and second spatial dimensional with the offset relative to the default backing position”*. Language is reasoned to be new matter for the same reasons noted in bullet point 2 above.

Applicant is required to cancel the new matter in the reply to this Office Action.

9. The amendment filed 6/29/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not

supported by the original disclosure is as follows: In claim 23 “*wherein the selecting an offset further comprises: determining if the selected offset exceeds an error point, the error point comprising an indication of when an offset causes a feature of the at least one profile to be disturbed or destroyed; and if the selected offset exceeds the error point, generating a notification that the selected offset exceeds the error point.*” Language is reasoned to be new matter for the same reasons noted in bullet point 2 above.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Response to Arguments***

1. Applicant’s arguments, see pg 21, filed 6/29/2009, with respect to written description have been fully considered and are persuasive. The 112 1<sup>st</sup> rejections of claims 5-16 has been withdrawn.
2. Applicant’s arguments, see pg 22, filed 6/29/2009, with respect to indefiniteness have been fully considered and are persuasive. The 112 2nd rejections of claims 5-12 has been withdrawn.
3. Applicant’s arguments, see pg 23, filed 6/29/2009, with respect to omitting essential structure have been fully considered and are persuasive. The 112 2nd rejections of claims 13-16 has been withdrawn.
4. Applicant’s arguments, see pg 20, filed 6/29/2009, with respect to non-statutory subject matter pertaining to the claiming of a human being have been fully considered and are persuasive. The 101 rejection of claims 1-4 has been withdrawn.
5. Applicant’s arguments filed 6/29/2009 in reference to Claims 1-4 as a non-statutory process have been fully considered but they are not persuasive. Transformation requires more than taking a drawing and creating a part out of said drawing.
6. Applicant’s arguments filed 6/29/2009, with respect to non-statutory subject matter have been fully considered and are persuasive. The 101 rejection of claims 13-16 has been

withdrawn. The drawings and specification include evidence of structure to carry out the means for functions.

### ***Claim Rejections - 35 USC § 101***

1. **Claims 1-4** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim is statutory either by showing that his claim is tied to a particular machine, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test. *In re Bilski*, slip opinion 2007-1130 (Fed. Cir. October 30, 2008).

Here, applicant's method steps fail the first prong of the new test because there is no particular machine. Further, applicant's method steps fail the second prong of the test because the claimed steps do not result in an article being transformed from one state to another. There is no transformation occurring in the claims for a physical object or substance or data that represents physical objects or substances.

The claims as recited are not tied to a particular machine and do not transform the numerical data inputted into a different state or thing. Therefore, the claims do not recite statutory subject matter.



1. **Claims 9-11** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A “processor” defined merely by software or terms synonymous with software is not deemed statutory. The apparatus as recited does not have any structural definition within the claims without the structure, the apparatus does not fit within the four statutory classes of method, apparatus, an article of manufacture and composition of matter.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1, 3, and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jensen (US 2001/0032111)*, hereinafter “*Jensen*”, in view of, *Lilly (US 6, 388, 626)*, hereinafter “*Lilly*”, in further view of, *Suto (US 2003/0214069)*, hereinafter, “*Suto*”.

**Referring to Claims 1 and 17**, *Jensen* discloses a method for custom manufacturing (assembly) of a tangible device (*Jensen*, abstract and [17 and 30] where the stone is “a tangible device”), comprising: receiving an order (*Jensen* [18]), wherein the order at least comprises one drawing (*Jensen* [44] where the drawing can be an attribute of purchased product), and wherein the at least one drawing at least comprises at least one part of a plurality of parts that comprise a unit (*Examiner finds*) the make-up of the drawing to be nonfunctional descriptive material not

functionally involved in the steps recited. The step of receiving an order would be performed the same regardless of whether there is a drawing or what is on the drawing. It is also well known that a product ordered can be made of multiple parts'. Thus, this" descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 431, 434, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)); storing the order (Jensen [25]); referencing the at least one first part to a database of units and parts (Jensen [26]), if no mold exists in the inventory of molds, then manufacturing or buying a mold for the at least one first part (Jensen [23] where the materials" could reasonably be a mold); determining if a suitable unused part of a plurality of unused parts exists within an inventory of unused parts by an associated part identifier (Jensen [26] components" or raw materials" on-site).

*However, although it is well known in the art to use part identifiers to locate parts, Jensen does not explicitly disclose this step and although it discloses making a device with multiple layers, it does not explicitly disclose the use of a mold.*

*Lilly discloses a computerized system provided for scheduling a plurality of work orders wherein the least one first part number is associated with the at least one first part (Lilly col 4 lines 6-11 where apart is" material identified by apart number); wherein each unused part of the plurality unused parts have part identifiers associated therewith (Lilly col 4 lines 6-11 where a part is" material identified by a part number), if no suitable part exists in the inventory of unused parts, then determining if a mold for the at least one part exists in an inventory of molds (Lilly col 5 lines 41-52 where the mold is" a resource per col 4 lines 12-15) and if a mold exists in the inventory of molds, then determining if the mold is available (Lilly col 5 lines 41-52 where the*

*mold is" a resource per col 4 lines 12-15) and retrieving the mold, once available (Lilly col 5 lines 41-52 where the mold is" a resource per col 4 lines 12-15).*

*Suto* discloses an automated process of creating a custom made part, that teaches casting the at least one first part with the mold that has been retrieved (*Suto* [41]).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a part number and a mold as a tool as taught by *Lilly* and to cast the mold as taught by *Suto* in combination with the method of *Jensen*, in order to more effectively facilitate and at least partially automate the process of selection, identification, design and manufacturing of custom decorative stonework products.

**Referring to Claim 3**, *Jensen* in view of *Lilly* disclose a method wherein the step of determining if the mold is available as in Claim 1 and *Lilly* discloses retrieving a schedule of use for the mold (*Lilly* col 5 lines 41-52 where the mold is" a resource per col 4 lines 12-15) and determining periods of time when the mold is in use for other projects (*Lilly* col 5 lines 41-52).

3. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Jensen* in view of Claim 1, in further view of *Kirkevold* (US 6,263,322), hereinafter "*Kirkevold*".

**Referring to Claim 2**, *Jensen* in view of *Lilly* in further view of *Suto* disclose, wherein the step of determining if a suitable unused part of the plurality of unused parts exists within the inventory of unused parts as in Claim 1 and *Jensen* discloses determining if the suitable unused part has correct dimensions (*Jensen* [26] where the computer notes the needed size and shape of the device); and if the suitable unused part is too large, then cutting the suitable unused part to the correct dimensions (*Jensen* [31 ]).

However, they not explicitly disclose the step of searching part identifiers associated with each of the unused parts to find the part that matches that part identifier.

*Kirkevold* discloses searching part identifiers associated with each of the unused parts of the plurality of unused parts for a part identifier that at least matches the at least one first part identifier associated with the at least one first part to determine if the suitable part identifier exists within the inventory of unused parts (col 6 lines 45-57).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to associate a part identifier with a part and use that as a method of searching as taught in *Kirkevold*, in order to effectively ascertain if the needed part was available.

4. **Claims 5, and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jensen* in view of *Lilly* in further view of *Suto*.

**Referring to Claim 5**, *Jensen* discloses a computer program product for custom manufacturing tangible devices the computer program product having a medium with a computer program embodied thereon (Jensen [18 and 25] where there is" a system that utilizes a computer to communicate the processes where the code is" inherently embedded within the computer), the computer program comprising: computer code for receiving an order (Jensen [19] where Examiner finds the type of content of the order to be nonfunctional descriptive material not functionally involved in the code recited. The code needed to perform the step would be performed the same regardless of the content of the order. Thus, this" descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re

Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)), wherein the order at least comprises one drawing, and wherein the at least one drawing at least comprises at least one part of a plurality of parts that comprise a unit; computer code for storing the order [Jensen 25]; computer code for referencing the at least one first part to a database of units and parts [Jensen 25 and 26], wherein the least one first part number is associated with the at least one first part (*Lilly abstract define the art as a computerized system that inherently utilizes code and col 4 lines 6-11 where a part is material identified by a part number*); wherein each unused part of the plurality unused parts have part identifiers associated therewith (*Examiner finds the associated identifiers to be nonfunctional descriptive material not functionally involved in the steps recited. The code for referencing would be performed the same regardless of the type of identifier. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 491, 494, (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)*); if no suitable part exists in the inventory of unused parts, then if no mold exists in the inventory of molds, then computer code for manufacturing or computer code for buying a mold for the at least one first part (*Jensen [23] where the materials could reasonably be a mold*); computer code for determining if a suitable unused part of a plurality of unused parts exists within an inventory of unused parts by an associated part identifier (*Lilly col 4 lines 6-11 where a part is material identified by a part number*),

However, although it is well known in the art to use part identifiers to locate parts, *Jensen* does not explicitly disclose the code to perform this step and although it discloses making a device with multiple layers, it does not explicitly disclose the code to use a mold.

*Lilly* discloses a computerized system that inherently operates using code computer code where the code determines if a mold for the at least one part exists in an inventory of molds (*Lilly* col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15); if a mold exists in the inventory of molds, then computer code for determining if the mold is available (*Lilly* col 5 lines 41-52 where the mold is "a resource per col 4 lines i2-i5"); and computer code for retrieving the mold, once available (*Lilly* col 5 lines 41-52 where the mold is "a resource per col 4 lines i2-i5), manufactured, or bought.

*Suto* discloses an automated process of creating a block, which is a tangible device, that discloses casting the at least one first part with the mold that has been retrieved (*Suto* where the automation inherently has code [4i]).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a part number and a mold as a tool as taught by *Lilly* and to cast the mold as taught by *Suto* in combination with the method of *Jenson*, in order to more effectively facilitate and at least partially automate the process of selection, identification, design and manufacturing of custom decorative stonework products.

**Referring to Claim 7,** *Jensen* and *Lilly* disclose a computer program product comprised of code wherein determining if the mold is available as in Claim 5 and *Lilly* further discloses code that retrieves a schedule of use for the mold (*Lilly* col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15) and determining periods of time when the mold is in use for other projects (*Lilly* col 5 lines 41-52).

5. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Jensen* in view of Claim 5, in further view of *Kirkevold*.

**Referring to Claim 6.** Jensen, Lilly and Suto disclose, wherein the computer code of determining if a suitable unused part of the plurality of unused parts exists within the inventory of unused parts as in Claim 5 and Jensen further discloses determining if the suitable unused part has correct dimensions (Jensen [26] where the computer notes the needed size and shape of the device); and if the suitable unused part is too large, then cutting the suitable unused part to the correct dimensions (Jensen [31]).

However, they not explicitly disclose the step of searching part identifiers associated with each of the unused parts.

*Kirkevold* discloses computer code is enabled to search part identifiers associated with each of the unused parts of the plurality of unused parts for a part identifier that at least matches the at least one first part identifier associated with the at least one first part to determine if the suitable part identifier exists within the inventory of unused parts (col 6 lines 45-57).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to associate a part identifier with a part and use that as a method of searching as taught in *Kirkevold*, in order to effectively ascertain if the needed part was available.

6. **Claims 9, and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen in view of Lilly in further view of Suto.

**Referring to Claim 9,** *Jensen* discloses a processor for custom manufacturing a tangible device, the computer program (*Jensen [18 and 25]* where there is a system that utilizes a computer to communicate the processes where the code is inherently embedded within the computer), the computer program comprising: computer code for receiving an order (*Jensen [19]* where Examiner finds the type of content of the order to be nonfunctional descriptive material not functionally involved in the code recited. The code needed to perform the step would be performed the same regardless of the content of the order. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)), wherein the order at least comprises one drawing, and wherein the at least one drawing at least comprises at least one part of a plurality of parts that comprise a unit; computer code for storing the order [*Jensen 25*]; computer code for referencing the at least one first part to a database of units and parts [*Jensen 25 and 26*], wherein the least one first part number is associated with the at least one first part (*Lilly abstract the art as a computerized system that inherently utilizes code and col 4 lines 6-11 where a part is material identified by a part number*); wherein each unused part of the plurality unused parts have part identifiers associated therewith (*Examiner finds the associated identifiers to be nonfunctional descriptive material not functionally involved in the steps recited. The code for referencing would be performed the same regardless of the type of identifier. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)); if no suitable part exists in the inventory of unused parts,



then if no mold exists in the inventory of molds, then computer code for manufacturing or computer code for buying a mold for the at least one first part (*Jensen [23] where the materials "could reasonably be a mold)*;

However, although it is well known in the art to use part identifiers to locate parts, *Jensen* does not explicitly disclose the code to perform this step and although it discloses making a device with multiple layers, it does not explicitly disclose the code to use a mold.

*Lilly* discloses a computerized system that inherently operates using code computer code where the code determines if a mold for the at least one part exists in an inventory of molds (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*); if a mold exists in the inventory of molds, then computer code for determining if the mold is available (*Lilly col 5 lines 41-52 where the mold is "a resource per col 4 lines 12-15),"* and computer code for retrieving the mold, once available (*Lilly col 5 lines 41-52 where the mold is "a resource per col 4 lines 12-15),* manufactured, or bought.

*Suto* discloses an automated process of creating a block, which is a tangible device, that discloses casting the at least one first part with the mold that has been retrieved (*Suto where the automation inherently has code [41]*).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a part number and a mold as a tool as taught by *Lilly* and to cast the mold as taught by *Suto* in combination with the method of *Jenson*, in order to more effectively facilitate and at least partially automate the process of selection, identification, design and manufacturing of custom decorative stonework products.

**Referring to Claim 11.** *Jensen and Lilly* disclose a computer program product comprised of code wherein determining if the mold is available as in Claim 9 and Lilly further discloses code that retrieves a schedule of use for the mold (Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15) and determining periods of time when the mold is in use for other projects (Lilly col 5 lines 41-52).

7. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen in view of Claim 9, in further view of Kirkevold.

**Referring to Claim 10.** Jensen, Lilly and Suto disclose, wherein the computer code of determining if a suitable unused part of the plurality of unused parts exists within the inventory of unused parts as in Claim 9 and Jensen further discloses determining if the suitable unused part has correct dimensions (Jensen [26] where the computer notes the needed size and shape of the device); and if the suitable unused part is too large, then cutting the suitable unused part to the correct dimensions (Jensen [31]).

However, they not explicitly disclose the step of searching part identifiers associated with each of the unused parts.

*Kirkevold* discloses computer code is enabled to search part identifiers associated with each of the unused parts of the plurality of unused parts for a part identifier that at least matches the at least one first part identifier associated with the at least one first part to determine if the suitable part identifier exists within the inventory of unused parts (col 6 lines 45-57).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to associate a part identifier with a part and use that as a method of

searching as taught in *Kirkevold*, in order to effectively ascertain if the needed part was available.

8. **Claims 13 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jensen* in view of *Lilly* in further view of *Suto*.

**Referring to Claim 13.** Jensen discloses an apparatus for custom manufacturing tangible devices (Jensen abstract and [18 and 25] )comprising: mean for receiving an order (Jensen [19] where Examiner finds the type of content of the order to be nonfunctional descriptive material not functionally involved in the code recited. The means needed to perform the step would be performed the same regardless of the content of the order. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)), wherein the order at least comprises one drawing, and wherein the at least one drawing at least comprises at least one part of a plurality of parts that comprise a unit; computer code for storing the order [Jensen 25]; means for referencing the at least one first part to a database of units and parts [Jensen 25 and 26], wherein the least one first part number is associated with the at least one first part(Lilly abstract define *the art as a computerized system that inherently utilizes code and col 4 lines 6-11 where a part is material identified by a part number*); wherein each unused part of the plurality unused parts have part identifiers associated therewith (*Examiner finds the associated identifiers to be nonfunctional descriptive material not functionally involved in the steps recited. The code for referencing would be performed the same regardless of the type of identifier. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381,*

*1385, 217 USPQ 401, 404, (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)); if no suitable part exists in the inventory of unused parts, then if no mold exists in the inventory of molds, then means for manufacturing or computer code for buying a mold for the at least one first part (Jensen [23] where the materials could reasonably be a mold); means for determining if a suitable unused part of a plurality of unused parts exists within an inventory of unused parts by an associated part identifier (Lilly col 4 lines 6-11 where a part is material identified by a part number),*

However, although it is well known in the art to use part identifiers to locate parts, *Jensen* does not explicitly disclose the mean for performing this step and although it discloses making a device with multiple layers, it does not explicitly disclose the means for using a mold.

*Lilly* discloses an apparatus with a means for determining if a mold for the at least one part exists in an inventory of molds (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*); if a mold exists in the inventory of molds, then computer code for determining if the mold is available (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*); and computer code for retrieving the mold, once available (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*), manufactured, or bought.

*Suto* discloses a means for creating a block, which is a tangible device, that discloses casting the at least one first part with the mold that has been retrieved (*Suto [41]*).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a part number and a mold as a tool as taught by *Lilly* and to cast the mold as taught by *Suto* in combination with the method of *Jenson*, in order to more

effectively facilitate and at least partially automate the process of selection, identification, design and manufacturing of custom decorative stonework products.

**Referring to Claim 15.** Jensen and Lilly disclose a means for determining if the mold is available as in Claim 13 and Lilly further discloses a means for retrieving a schedule of use for the mold (Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15) and determining periods of time when the mold is in use for other projects (Lilly col 5 lines 41-52).

9. **Claim 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Jensen* in view of Claim 13, in further view of *Kirkevold*.

**Referring to Claim 14.** Jensen, Lilly and *Suto* disclose a means for determining if a suitable unused part of the plurality of unused parts exists within the inventory of unused parts as in Claim 13 and Jensen further discloses determining if the suitable unused part has correct dimensions (*Jenson [26] where the computer notes the needed size and shape of the device*); and if the suitable unused part is too large, then cutting the suitable unused part to the correct dimensions (*Jensen [31]*).

However, they not explicitly disclose the step of searching part identifiers associated with each of the unused parts.

*Kirkevold* discloses a means for searching part identifiers associated with each of the unused parts of the plurality of unused parts for a part identifier that at least matches the at least one first part identifier associated with the at least one first part to determine if the suitable part identifier exists within the inventory of unused parts (*col 6 lines 45-57*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to associate a part identifier with a part and use that as a method of searching as taught in *Kirkevoid*, in order to effectively ascertain if the needed part was available.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEWANA SKINNER whose telephone number is (571)270-7141. The examiner can normally be reached on Monday-Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mooneyham Janice can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689